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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,107	10/12/2001	Heikki Einola	875.0010USU	5728
29683	7590	06/02/2006	EXAMINER	
HARRINGTON & SMITH, LLP 4 RESEARCH DRIVE SHELTON, CT 06484-6212			COLIN, CARL G	
			ART UNIT	PAPER NUMBER
			2136	

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,107

Applicant(s)

EINOLA ET AL.

Examiner

Carl Colin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. In response to communications filed on 3/17/2006, applicant amends claims 1, 4, 8, and 9. The following claims 1-14 and 20-23 are presented for examination.

1. 1 Applicant's remarks, pages 6-9, filed on 3/17/2006, with respect to the rejection of claims 1-14 and 20-23 have been fully considered but they are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2.1 **Claims 1-14, and 20-23** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,199,069 to **Favichia et al** in view of European Patent Application EP-0779760 to **Hamalainen** (*Applicant's Disclosure*).

2.2 **As per claim 4, Favichia et al** discloses a method of ciphering in a communication network comprising a user equipment, an access network and a plurality of core networks, wherein said user equipment is configured to be simultaneously in communication with at least two of said plurality of core networks, said method comprising: communicating separate protocols comprising codeset parameters from at least two of a plurality of core networks where HLR and MSC 12, MSC 22, and MSC 32 are located that meets the recitation of communicating separate ciphering parameters to said access network from said at least two of said plurality of core networks (see column 3, line 57 through column 4, line 6 and column 4, lines 38-52 and figure 1); selecting one of said separate protocols and using the selected one for ciphering at least both a communication between said user equipment and a first core network of said plurality of core networks of said plurality of core networks (see column 2, line 59 through column 3, line 15 and column 4, line 38-52). **Favichia et al** is silent about ciphering algorithm or key, however, **Favichia et al** discloses communicating separate protocols comprising codeset parameters as indicated above and encoding values (column 4, lines 61-67), which could be interpreted as means for ciphering communication. Official notice is taken by Examiner that it is very well known that wireless communication protocol may include key and ciphering algorithm as part of the as part of the protocol for authentication and ciphering of messages. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

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modify the protocol selection method of using codeset parameters of **Favichia et al** to use ciphering parameters for ciphering information related to the subscriber in the selection process so as to protect the identity of the subscriber. One of ordinary skill in the art would have been lead to make such a modification because it would protect the true identity of subscribers of the mobile stations since the information is sent in cipher form as known in the art.

As per claims 8 and 9, Favichia et al discloses network nodes wherein at least one node is capable of operating in at least two different protocols (see column 1, lines 4-15) that meets the recitation of an access network and access network element comprises means for receiving separate ciphering parameters and means for selecting one of said separate ciphering parameters as indicated in claim 1 (see also claims 11-19). Therefore, claims 8-9 are rejected on the same rationale as the rejection of claim 1.

As per claim 1, claim 1 contains similar limitations as claim 8 except for including the limitation of wherein said user equipment is configured to be simultaneously in communication with at least two of said plurality of core networks. **Favichia et al** also discloses a user equipment that is configured to be simultaneously in communication with at least two of said plurality of entities (see column 1, lines 24-42).

As per claims 2, 5, and 10, Favichia et al discloses means for ciphering said communications between said user equipment and said at least two of said plurality of core

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networks with said selected one of said separate ciphering parameter (see column 4, lines 38-47), these claims are also rejected on the same rationale as the rejection of claim 1 above.

As per claims 3, 6, and 13, Favichia et al discloses communicating separate protocols comprising codeset parameters as indicated in claim 1 and comprising encoding values (column 4, lines 61-67), the limitation of wherein said ciphering parameter comprises at least one of a ciphering key or a ciphering algorithm, is rejected on the same rationale as the rejection of claim 1 above.

As per claim 7, Favichia et al substantially discloses an access network comprising plurality of entities dedicated for managing the ciphering of communications with user equipments located in a geographical area allocated to said respective entities (see figure 1 with description) and when a user equipment moves from a geographical area allocated to a first ciphering managing entity to a geographical area allocated to a second ciphering managing entity said first ciphering managing entity communicates used ciphering parameters to a second ciphering managing entity by signaling over said at least two of said plurality of core networks (see column 3, line 57 through column 4, line 6).

As per claims 11-12, 20-21, and 22-23, Favichia et al discloses wherein said communications comprising signaling messages and user data (see column 4, lines 7-18).

As per claim 14, Favichia et al discloses the claimed device of claim 9 further comprising a radio network controller in the access network element (see column 1, lines 25-28).

Conclusion

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

3.1 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cc

Carl Colin

Patent Examiner

May 26, 2006


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100